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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/734,442	12/12/2003	Helmut Steinhilber	074623.0111	9668
7590	11/21/2006		EXAMINER [REDACTED]	JOERGER, KAITLIN S
Andreas Grubert Baker Botts L.L.P. One Shell Plaza 910 Louisiana Houston, TX 77002-4995			ART UNIT [REDACTED]	PAPER NUMBER 3653

DATE MAILED: 11/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/734,442	STEINHILBER ET AL.	
	Examiner	Art Unit	
	Kaitlin S. Joerger	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 13 September 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 4 and 11-13 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-3,5-10 and 14-17 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 12 December 2003 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) Notice of Informal Patent Application
- 6) Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

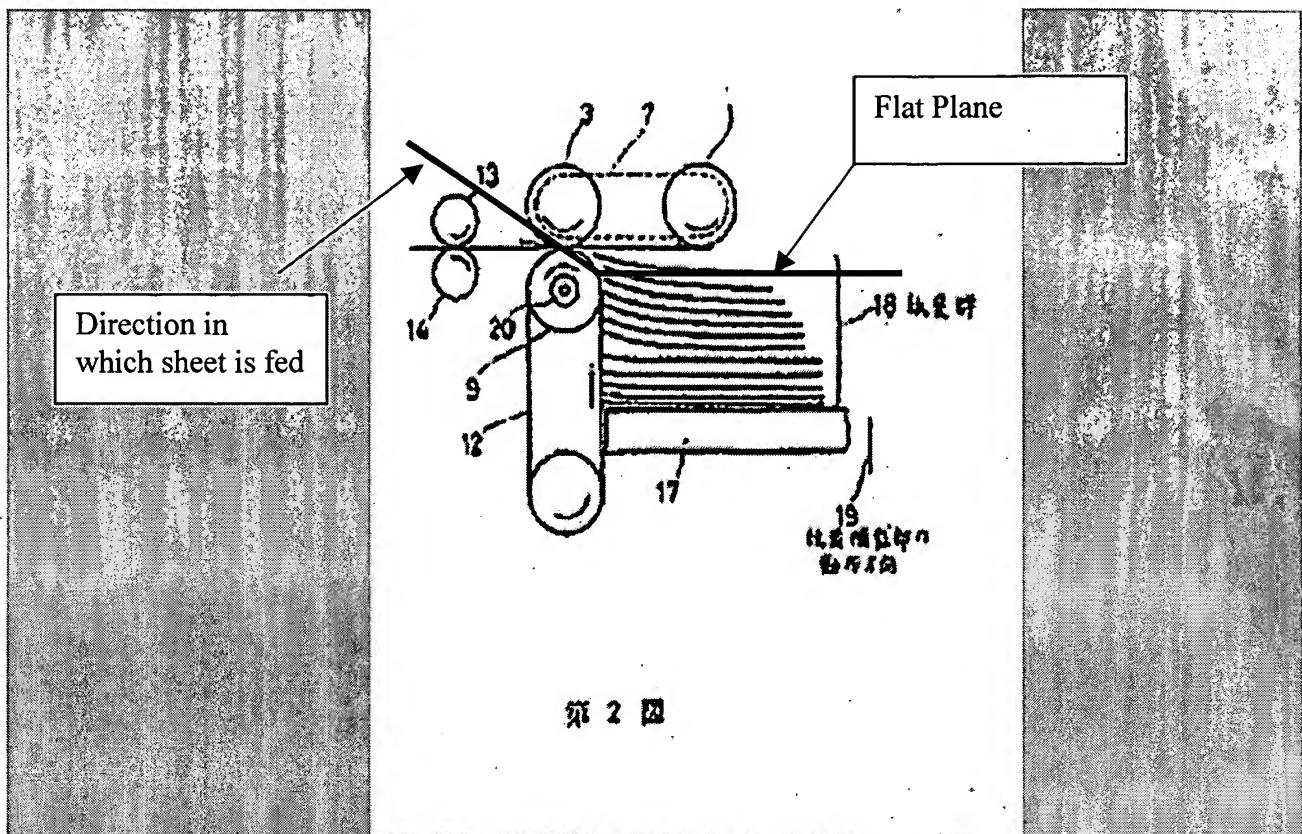
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 6-10 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 62240237 A.

The JP '037 patent teaches a device for selecting sheets of a record carriers from a pile, comprising:

- a rolling action device, 1, that lies on the uppermost sheet of the pile and exerts a rolling action on the uppermost sheet in a feeding direction, see figure 2;
- a stop, 12, mounted before the front edge of the pile pointing in the feeding direction, the front edge of the sheet is moved against the stop and wherein the stop can be moved upwards at an angle of more than 90 degrees to the flat plane and direction in which the sheet is fed, see figure 2 reproduced below:



As is clearly shown in the picture, the angle between the flat plane and the direction in which the sheet is feed in clearly more than 90 degrees.

The JP '037 patent further teaches:

- the stop moves in the plane of its surface;
- the stop is built of a belt, which runs upward under the impingement angle;
- the belt is an endless belt whose planar surface is turned towards the pile.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62240237

A.

Although the JP '237 patent does not specifically teach a method for selecting sheets from a pile, it would have been obvious to one of ordinary skill in the art to perform the method steps of claims 1-3 using the apparatus taught by the JP '237 reference at the device of the JP '237 comprises all the feature of the claimed invention and would perform the claimed method steps when used in its usual and expected manner.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62240237 A in view of U.S. Patent No. 4,579,329.

The JP '237 patent does not teach a selection method wherein a dividing element is moved between the lifted front edge and the next sheet in the pile, but the '329 patent does. It would have been obvious to one of ordinary skill in the art to combine the dividing element of the '329 patent with the apparatus of the '237 patent in order to surely separate the top sheet from the pile and prevent two or more sheets from being removed from the pile at one time.

Claims 14-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 62240237 A in view of U.S. Patent No. 4,579,329.

The JP '237 patent does not teach a dividing element that can be moved between the lifted front edge and the next sheet in the pile, but the '329 patent does. The '329 patent teaches a

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dividing element, 20, mounted before the front edge of the pile that can be moved between the uppermost sheet and the following sheet in the pile, the dividing element intervenes by means of a finger and includes a press-on roller, see figure 8.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the dividing element of the '329 patent with the apparatus of the '237 patent in order to surely separate the top sheet from the pile and prevent two or more sheets from being removed from the pile at one time.

Response to Arguments

Applicant's arguments filed 13 September 2006 have been fully considered but they are not persuasive. The applicant argues that the JP '237 reference does not teach the feature of a stop that is moved at an angle of more than 90 degrees in relation to a flat plane and a direction in which the sheet is being feed. It is clear from the figures shown above that as the stop, belt 12, moves up and over the top roller 9 it moves up an angle that is greater than 90 degrees to a flat plane, where the flat plane is the plane of the stack of sheets. Therefore, the JP '237 does in fact teach all the feature of the claimed inventions and claims 1-3, 5-10, and 14-17 remain rejected.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

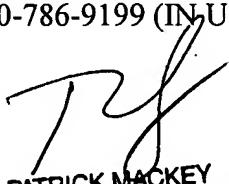
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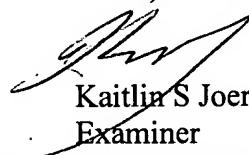
MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kaitlin S. Joerger whose telephone number is 571-272-6938. The examiner can normally be reached on Monday - Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Mackey can be reached on 571-272-6916. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


PATRICK MACKEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600


Kaitlin S Joerger
Examiner
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